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Frank C. Nicholas CARDINAL LAW GROUP Suite 2000 1603 Orrington Avenue Evanston, IL 60201		EXAMINER NGUYEN, THANH T		
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/731,624
Filing Date: December 07, 2000
Appellant(s): FRENCH ET AL.

Frank C. Nicholas
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

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This is in response to the appeal brief filed November 17, 2005 appealing from the Office action mailed September 9, 2005 and response to the Supplemental Appeal Brief filed June 8, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments

The appellant's statement of the status of amendments rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,182,275	BEELITZ	01-2001
5,905,872	DESIMONE	5-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 12-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Beelitz et al. (USPN January 30, 2001 – Date of Patent: 6,182,275, herein referred to as “Beelitz”).

3. As to claim 12, Beelitz teaches the invention as claimed, including computer program product in a computer usable medium for dynamically creating a list of operating systems for a target device in communication with a server, the target device to be remotely booted by the server, comprising: means for receiving at the target device an available operating systems list of at least one operating system available to the target device (col.7, lines 35-40, lines 48-51);

means for determining a hardware configuration of the target device (col.18, lines 60-65); means for determining if the hardware configuration is compatible with each operating system from the available operating systems list (col.16, lines 4-10); and means for generating a compatible operating systems list (col.18, lines 5-10).

4. As to claim 13, Beelitz teaches the invention as claimed, further comprising: means for discovering the hardware configuration via a network discovery process (col.2, lines 2, lines 10-18).

5. As to claim 14, Beelitz teaches the invention as claimed, further comprising: means for determining at least one location-based operating system based on the location of the target device (col.15, lines 55-65).

6. As to claim 15, Beelitz teaches the invention as claimed, further comprising: means for adding the location-based operating system to the available operating systems list (col.16, lines 1-10).

7. As to claim 16, Beelitz teaches the invention as claimed, further comprising: means for determining if the hardware configuration is compatible with the location-based operating system (col.16, lines 1-9).

8. As to claim 17, Beelitz teaches the invention as claimed, further comprising: means

for adding the location-based operating system to the compatible operating systems list if the hardware configuration is compatible with the location-based operating system (col.15, lines 55-65).

9. As to claim 18, Beelitz teaches the invention as claimed, further comprising: means for receiving a selection of a target operating system from the compatible operating system list (col.7, lines 35-40, lines 48-51); and means for sending the target operating system to the target device (col.15, lines 55-65).

10. As to claim 19, Beelitz teaches the invention as claimed, further comprising: means for executing a network bootstrap on the target device before the target operating system is selected (col.7, lines 35-40, lines 48-51).

11. As to claim 20, Beelitz teaches the invention as claimed, further comprising: means for relocating the network bootstrap after the target operating system is selected (col.18, lines 60-65).

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-11, 21-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beelitz et al.,(hereinafter Beelitz) U.S. Patent No. 6,182,275 in view of DeSimone et al., (hereinafter DeSimone) U.S. Patent No. 5,905,872.

14. As to claim 1, Beelitz teaches the invention as claimed, including a method of dynamically creating a list of operating systems for a target device in communication with a server the target device to be remotely booted by the server, prior to executing an operating system on the target device, comprising: receiving, at the target device, an available operating systems of at least one operating system available to the target device (see col.7, lines 35-40, lines 48-51, and col.16, lines 35-38); determining a hardware configuration of the target device (see col. 18, lines 50-55); determining if the hardware configuration is compatible with each operating system from the available operating systems list (see col.11, lines 50-55, and col.16, lines 4-10); and generating a compatible operating systems list (see Abstract, col.4, lines 40-50, and col.18, lines 5-10). But Beelitz does not explicitly teach a server send a list. However, DeSimone teaches a server send a list (see col.5, lines 47-51). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the teachings of DeSimone into the computer system of Beelitz to process XML documents because it would have an efficient system that can help to save resources and times of the user.

15. As to claim 2, Beelitz teaches the invention as claimed, wherein the hardware configuration is determined by a network discovery process (col.2, lines 2, lines 10-18).

16. As to claim 3, Beelitz teaches the invention as claimed, further comprising: mapping a specific location of the target device (col.15, lines 55-65).

17. As to claim 4, Beelitz teaches the invention as claimed, further comprising: determining at least one location-based operating system that is based on the specific location of the target device (col.15, lines 55-65).

18. As to claim 5, Beelitz teaches the invention as claimed, further comprising: determining if the hardware configuration is compatible with the location-based operating system (col.16, lines 1-9).

19. As to claim 6, Beelitz teaches the invention as claimed, wherein the compatible operating systems list does not include the location-based operating system, further comprising: adding the location-based operating system to the compatible operating systems list (col.16, lines 5-10).

20. As to claim 7, Beelitz teaches the invention as claimed, wherein the available operating systems list does not include the location-based operating system, further comprising: adding the location-based operating system to the available operating systems list (col.16, lines 1-10).

21. As to claim 8, Beelitz teaches the invention as claimed, further comprising: selecting, at the target device, a target operating system from the compatible operating system list (col.16, lines 8-18).

22. As to claim 9, Beelitz teaches the invention as claimed, further comprising: receiving at the target device, the target operating system (col.15, lines 55-65).

23. As to claim 10, Beelitz teaches the invention as claimed, further comprising: providing an initial bootstrap to the target device; and executing the initial bootstrap on the target device before the target operating system is selected (col.7, lines 35-40, lines 48-51).

24. As to claim 11, Beelitz teaches the invention as claimed, further comprising: relocating the initial bootstrap after the target operating system is received (col.18, lines 60-65).

25. As to claim 21, Beelitz teaches the invention as claimed, including a network data processing system comprising: means for sending an available operating systems to a target device, the target device to be remotely booted by the server (see col.15, lines 1-45, and col.18, lines 11-28), prior to executing an operating system on the target device (col.7, lines 35-40, lines 48-51); means for determining a hardware configuration of the target device (col.18, lines 60-65); means for determining if the hardware configuration is compatible with each operating system from the available operating systems list (col.16, lines 4-10); and means for generating a compatible operating systems list (col.18, lines 5-10). But Beelitz does not explicitly teach a

server send a list. However, DeSimone teaches a server send a list (see col.5, lines 47-51). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the teachings of DeSimone into the computer system of Beelitz to process XML documents because it would have an efficient system that can help to save resources and times of the user.

26. As to claim 22, Beelitz teaches the invention as claimed, further comprising: means for determining a specific location of the target device (col.15, lines 55-65); means for determining at least one location-based operating system that is based on the specific location (col.15, lines 55-65); and means for determining if the location-based operating system is compatible with the hardware configuration (col.16, lines 4-10).

27. As to claim 23, Beelitz teaches the invention as claimed, further comprising: means for executing a network bootstrap program on the target device before a target operating system is selected (col.7, lines 35-40, lines 48-51); means for selecting the target operating system from the compatible operating systems list (col.15, lines 55-65); means for relocating the network bootstrap program after the target operating system is selected (col.18, lines 60-65); and means for sending the target operating system to the target device (col.16, lines 1-10).

28. As to claim 24, Beelitz teaches the invention as claimed, including a method for dynamically creating a list of operating systems for a target device in communication with a server, the target device to be remotely booted by the server, prior to executing an operating

system on the target device, comprising: receiving from the server, at the target device, an available operating systems list of at least one operating system available to the target device (see col.7, lines 35-40, lines 48-51, and col.16, lines 35-38); determining a hardware configuration of the target device (see col. 18, lines 50-55); determining if the hardware configuration is compatible with each operating system from the available operating systems list (see col.11, lines 50-55, and col.16, lines 4-10); and generating a compatible operating system list (Fig.2, list of compatible operating system type 626); selecting a preferred operating system for the target device from the compatible operating systems list (Fig.2, 629); and executing the preferred operating system on the target device (Fig.1) (see col.4, lines 10-58, col.18, lines 30-44). But Beelitz does not explicitly teach a server send a list. However, DeSimone teaches a server send a list (see col.5, lines 47-51). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the teachings of DeSimone into the computer system of Beelitz to process XML documents because it would have an efficient system that can help to save resources and times of the user.

29. As to claim 25, Beelitz teaches the invention as claimed, wherein selecting operating system for the target device comprises an automatic selection (see col.10, lines 1-18, and col.13, lines 25-40).

30. As to claim 26, Beelitz teaches the invention as claimed, wherein selecting a preferred operating system for the target device comprises a selection by a system administrator (see col.6, lines 55-65, and col.7, lines 35-65).

31. As to claim 27, Beelitz teaches the invention as claimed, wherein selecting a preferred operating system for the target device comprises a selection by a user (see col.4, lines 40-65, and col.7, lines 35-65).

(10) Response to Argument

- Appellant argues that Beelitz does not disclose “*means for receiving at the target device an available operating system list of at least one operating system available to the target device*”.

Examiner respectfully disagrees. The Applicant argument is vague. Beelitz discloses means for receiving at the target device an available operating system list of at least one operating system available to the target device as shown in col. 7, lines 35-40 (*the master data base 125 to create or generate a list of operating system available for the targeted computer system*).

- Appellant argues that Beelitz in view of DeSimone does not disclose “*a method of dynamically creating a list of operating systems for a target device in communication with a server prior to executing a operating system on the target device*”

In response to applicant's arguments, the recitation “*a method of dynamically creating a list of operating systems for a target device in communication with a server prior to executing a operating system on the target device*” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable

weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

- Appellant argues that DeSimone does not teach “server send a list”.

Examiner respectfully disagrees. The Applicant argument is vague. DeSimone discloses server send a list as shown in col. 5, lines 47-51 (*the server sends a list of the subnetwork address of each client*).

- Appellant argues that Beelitz does not disclose “*the target to be remotely booted by server*”.

Examiner respectfully disagrees. The Applicant argument is vague. Beelitz discloses the target device to be remotely booted by server as shown in col. (*the master data base 125 to create or generate a list of operating system available for the targeted computer system*).

- Appellant argues that any combination of references can not support a rejection.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the

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
knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, I would have been obvious to one of ordinary skill in the art at the time of the invention as made to implement the teaching of DeSimone into the computer system to have a server send a list because it would have efficient system that can help to save resources and time of the user.

(11) Related Proceeding(s) Appendix

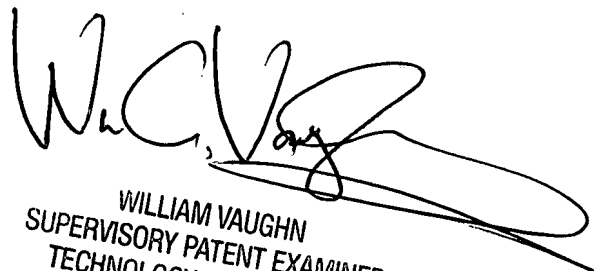
No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.


For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


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Art Unit 2144

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